Remarks

There is a single issue, i.e. whether claims 1 and 2 meet the enablement requirement of 35 U.S.C. 112, first paragraph.

Regardless of what the Office Action says the law is or the MPEP indicates the law is, the relevant case law provides that the burden is on the PTO to provide by evidence or suitable reasoning that there is unpredictability involved in the practice of the claims. See the case law cited in the response of March 27, 2008. No case law is cited in the final action which says otherwise.

It is noted that the undersigned has been involved in at last ten appeals on the issue set forth here. In all cases, the decision on appeal supported what the undersigned says is the law and a patent issued or the PTO withdrew its objection.

One relevant decision where the undersigned was involved is the decision on appeal in 09/757,610. A salient portion of the decision is quoted below.

> "[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support." In re Marzocchi, 439 F.2s 220, 2223, 169 USPQ 367, 369 (CCPA1971) (emphasis original). "[I]t is incumbent upon the Patent Office . . . to explain why it doubts the truth and accuracy of any statement in the supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." Id. at 224, 169 USPQ at 370. In other words, "the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection

> provided by [the] claim[s] is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specifications as to the scope of enablement." In re Wright, 999 F.2d 1557, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).
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> Thus, the issue is not whether appellants have established that the disclosure is enabling for the scope of the claims; the issue is whether the PTO has met its initial burden of setting forth a reasonable explanation as to why it is not.

Thus the issue is whether the PTO has carried its burden of proving unpredictability for practice of the claims.

We turn now to whether or not the PTO has carried its burden for proving the unpredictability in the practice of the claims.

The Office Action relies only on Mattick and Chan et al. for evidence (see pages 6 and 7) of the final action.

The PTO position on Mattick (page 5 of the final action), is that it is silent on whether connectrons are present. Applicant's position in response is that silence is not probative so Mattick proves nothing.

We turn now to Chan et al.

The final Office Action at pages 5 and 6 says:

> Chan et al. describes on pages 268-273, the unpredictability and difficulty of forming triplex structures that are linked to the purine motif or the pyrimidine motif.

At page 6, the final Office Action states:

> Chan et al. shows that triplex formation occurs only with oligonucleotides with a purine rich or pyrimidine rich motif, rather than with any identical sequence as suggested in the specification.

In reply, applicant finds that Chan et al. provides no data at all of its own and therefore shows nothing about triplex formation. The statements relied on in the final Office Action are rather conclusions based on hearsay recitations. Chan et al. therefore is not appropriate evidence.

Thus the PTO has failed to carry its burden.

Withdrawal of the rejection and allowance is requested.

Respectfully submitted,
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Date: June 18, 2008